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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,235	09/21/2000	Shaun Astarabadi	81087-250501	9216

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT PAPER NUMBER

2143

DATE MAILED: 03/04/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,235

Applicant(s)

ASTARABADI ET AL.

Examiner

Bunjob Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of invention Group I, claims 1-10 and 27-28 in Paper No. 3 is acknowledged. Claims 11-26 are cancelled; Claims 1-10 and 27-28 are pending for examination. The rejection cited is as stated below.

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

3. Applicant is required to submit a mark-up for a continuation-in-part application showing the subject matter added where there is an intervening reference (See. MPEP 704.11(a)(K).)

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4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhoads et al., (US. 2002/0090114) and Maloney et al., (US. 6,119,932).

6. Regarding claims 1, 6, Rhoads discloses, a method and apparatus, hereinafter referred to as "system" for providing media content to a user comprising: embedding, superimposing object identifier, e.g., information of basket ball player is embedded in a Jersey, with a media object such as video image frame or sequence of the video frame and transmitting the video frame to the user (Fig.1A-7; paragraphs 14, 17-18, 40-42, 34-36). Rhoads does not explicitly disclose the embedded information is information identifies a subscriber. However, in an analogous art, Maloney teaches an identification and validation system, which employ the superimposing technique for embedding user information with video frame for validation identification or users over a network (Maloney, Col. 1, lines 45-59; Col. 3, line 25-Col. 4, line 51). Thus, incorporating Maloney idea of superimposing user information with a system that readily capable to do so, as suggested in Rhoads, to superimpose subscriber information, would have been obvious to one of ordinary skill in the art at the time of the invention was made, with the motivation of enable system to identify and validate its subscribers, in order to provide appropriate services, because minimal modification is required as well as the expectation of success is reasonably high.

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7. Regarding claims 2-5 and 7-10, Rhoads-Maloney discloses providing a digitized image of the requested content including digitized video frames; and inserting a digitized image identifying the subscriber into at least some of the digitized video frames to provide the modified content (Rhoads, Fig. 1A-7; paragraphs 14, 17-18, 34-36; 40-42, 34-36; Maloney, Col. 1, lines 45-59; Col. 3, line 25-Col. 4, line 51).

8. Regarding claims 3-5 and 8-10, Rhoads-Maloney discloses the system, receiving video frame from VHS, i.e., analog, or DVD or MPEG, i.e., digitized; embedding water mark with in the frame, i.e., insert digitized image; the frame with the embedded objects are stored in both formats and presented to either, regular TV, i.e., presenting in analog format, or in a digitized TV or PC, i.e., presented in digital format. Thus, implicitly, Rhoads-Maloney has readily taught, storing, retrieving embedding converting e.g., ADC or DAC (See Rhoads paragraphs 87-94, 119, 124-142).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 27-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Barber et al., (US. 6,564,259).

11. Regarding claims 27-28, language of the claims directed to a method comprising a set of software instructions stored in a NV memory, i.e., hard disk or the like, in which when executed

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provide a web page comprising icon(s) for allowing a subscriber within an enterprise intranet to access the services in from of a list or menu both within the intranet an Internet, claims have been interpreted in light of specification as illustrated in Fig. 7.

Barber discloses a corporate intranet web page for providing service to its subscribers, e.g., employees. The web page includes a plurality of links, which are presented in various forms, such as hypertext link, buttons, icons and menu listing of services provided by the corporate and by the sources in the Internet (Fig 1-2, 11, 15, 19-20).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)?



Bunjob Jaroenchonwanit
Primary Examiner
Art Unit 2143

/bj